

06-05-06

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Docket No.: 65512 (70801)  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Tsutomu Nagaoka, et al.

Application No.: 10/578,383

Confirmation No.: N/A

Filed: May 5, 2006

Art Unit: Not Yet Assigned

For: ELECTRICAL RESISTIVITY SENSOR  
AND SENSING METHOD

Examiner: Not Yet Assigned

INFORMATION DISCLOSURE STATEMENT (IDS)

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

.....  
CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 (Express Mail Label No: EV 754871115 US), and is addressed to Mail Stop: AMENDMENT, Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 on June 1, 2006.

By

Kathryn A. Grindrod  
Kathryn A. Grindrod

.....  
Pursuant to 37 CFR 1.56, 1.97 and 1.98, the attention of the Patent and Trademark Office is hereby directed to the references/documents listed on the attached PTO/SB/08a/b. It is respectfully requested that these references/documents be expressly considered during the prosecution of this application, and that these references/documents be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

I COPIES

- a.   X   Submitted herewith is a legible copy of (i) each U.S and foreign patent; (ii) each publication or that portion which caused it to be listed; and (iii) all other information or that portion which caused it to be listed.
- b.        This application relies under 35 U.S.C. § 120, on the earlier filing date of prior application Serial No.       , filed on       . The references listed on the attached Form PTO/SB08a/b were submitted to, and/or cited by, the Office in the prior application(s) and, therefore, are not required to be provided in this application.

II. CONCISE EXPLANATION OF THE RELEVANCE

(check at least one box)

- a.   X   Except as may be indicated below in (b), all of the patents, publications or other information submitted herewith are in the English language or were cited in an English language Search Report, a copy of which is attached hereto (concise explanation not required).
- b.   X   A concise explanation of the relevance of all patents, publications or other information listed that is not in the English language is as follows:

See English language Abstracts attached to the documents BA-BC, BE-BH, BJ-BM and CB cited and provided herewith. Also, see attached English language translation of International Search Report in International Application No. PCT/JP2004/006583 that corresponds to this application regarding items BA-BK and CA-CD; page 1 of the present specification regarding items BL-BM; and page 2 of the present specification regarding items BN-BO.

- c.   X   The following additional information is provided for the Examiner's consideration:

A copy of an International Search Report in a corresponding application to this application and an English language translation thereof is attached.

**FEES**

III. THIS IDS IS BEING FILED UNDER 37 C.F.R. § 1.97(b)  
(check one box)

- a.   X   within three months of the filing date of a national application (37 C.F.R. § 1.97(b) (1)). No fee or certification is required.
- b.        within three months of the date of entry of the national stage as set forth in §1.491 in an international application (37 C.F.R. § 1.97(b) (2)). No fee or certification is required.
- c.        before the mailing date of a first Action on the merits (37 C.F.R. § 1.97(b) (3)). No fee or certification is required. In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the certification under 37 C.F.R. § 1.97(e) below, or, if no certification has been made, charge our deposit account a fee in the amount of \$180.00 as required by 37 C.F.R. § 1.17(p).

IV. THIS IDS IS BEING FILED UNDER 37 C.F.R. § 1.97(c):  
(check one box)

before the mailing date of a Final Office Action under 37 C.F.R. § 1.113 (See 37 C.F.R. § 1.97(c) (1)) or before the mailing date of a Notice of Allowance under 37 C.F.R. § 1.311 (See 37 C.F.R. § 1.97(c) (2)).

- a. \_\_\_\_\_ No certification; therefore, a fee in the amount of \$180.00 is required by 37 C.F.R. §1.17(p).

OR

- b. \_\_\_\_\_ See the certification below. No fee is required.

V. STATEMENT UNDER 37 C.F.R. § 1.97(e)  
(check only one box)

The undersigned hereby states that

- a. \_\_\_\_\_ each item of information contained in the IDS was first cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS; or
- b. \_\_\_\_\_ no item of information contained in the IDS was first cited in a communication from a foreign Patent Office in a counterpart foreign application or, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

- c. \_\_\_\_\_ Some of the items of information were cited in a communication from a foreign Patent Office. As to this information, the undersigned certifies that each item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby certifies that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application or, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

\_\_\_\_\_ Please charge Deposit Account No. 04-1105 in the amount of \$180.00 for the above-indicated fee. A triplicate copy of this paper is attached.

  X   No fee is required.

  X   Applicant believes that additional fees beyond those submitted herewith are not required in connection with the consideration of this submission. However, if for any reason a further fee is required, a fee paid is inadequate or a credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. 04-1105, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

If the Examiner has any questions concerning this Information Disclosure Statement, he/she is requested to contact the undersigned. Further, if it is determined that this Information Disclosure Statement has been filed under the wrong rule, the United States Patent and Trademark Office is requested to consider this Information Disclosure Statement under the proper rule, with a petition if necessary, and to charge the appropriate fee to Deposit Account No. 04-1105.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 65512 (70801). A duplicate copy of this paper is enclosed.

Dated: June 1, 2006

Respectfully submitted,

By *David A. Tucker*  
David A. Tucker  
Registration No.: 27,840  
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Substitute for form 1449A/B/PTO			<b>Complete if Known</b>		
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)			Application Number	10/578,383	
			Filing Date	May 5, 2006	
			First Named Inventor	Tsutomu Nagaoka, et al.	
			Art Unit	Not Yet Assigned	
			Examiner Name	Not Yet Assigned	
Sheet	1	of	1	Attorney Docket Number	65512 (70801)

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>2</sup> -Number <sup>3</sup> -Kind Code <sup>4</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>5</sup>
	BA	JP-05-322817	12-07-1993			✓
	BB	JP-2003-185662	07-03-2003			✓
	BC	JP-2003-522936	07-29-2003			✓
	BD	WO-02/48701-A2	06-20-2002			
	BE	JP-2002-228616	08-14-2002			✓
	BF	JP-2003-139775	05-14-2003			✓
	BG	JP-10-010065	01-16-1998			✓
	BH	JP-03-128449	05-31-1991			✓
	BI	JP-63-11861	01-19-1988			
	BJ	WO-99/57550	11-11-1999			✓
	BK	JP-2000-214120	08-04-2000			✓
	BL	JP-2003-287538	10-10-2003			✓
	BM	JP-2003-250088	09-05-2003			✓
	BN	JP-2003-514224	04-15-2003			
	BO	JP-2002-533698	10-08-2002			

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST 3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached. Abstract only.

NON PATENT LITERATURE DOCUMENTS					
Examiner Initials	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.			T <sup>5</sup>
	CA	Y. Yamamoto et al., "Proposition for a novel electric resistance type detecting DNA sensor using a gold nano particle film with nano-gap" The program of the 52nd meeting of the Japan Society for Analytical Chemistry, Sept. 9, 2003; p. 92.			
	CB	S. Tokunami et al., "Development of a DNA sensor using a gold nano particle film", The program of the 1st meeting of Society of Nano Science and Technology, May 29, 2003, p. 205.			✓
	CC	S. Tokunami et al., "Development of a DNA sensor using a gold nano particle film", The program of the 64th symposium of the Analytical Chemistry, May 10, 2003, p. 66.			
	CD	T. Nagaoka et al., "Development of an electric detection type DNA chip using a gold nano particle film", The program of the Introductory Fair of Technologies of Osaka Prefecture University, Oct. 16, 2003, p. 36.			

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature	/Nelson Yang/ (11/19/2009)	Date Considered	
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546376  
ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /N.Y./



Application No. (if known): 10/578,383

Attorney Docket No.: 65512 (70801)

## Certificate of Express Mailing Under 37 CFR 1.10

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on June 1, 2006  
Date

Kathryn A. Grindrod  
Signature

Kathryn A. Grindrod  
Typed or printed name of person signing Certificate

Registration Number, if applicable (617) 517-5534  
Telephone Number

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Information Disclosure Statement (6 pages)  
Form PTO/SB/08a/b (w/19 References) (2 pages)  
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